

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appellants : Stephen M. MUELLER et al.

Group Art Unit: 2614

Appln. No. : 10/840,224

Examiner: Quynh H. NGUYEN

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For : NETWORK DELIVERY OF PERSONALIZED CALLER IDENTIFICATION

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APPEAL BRIEF UNDER 37 C.F.R. § 41.37(d)

Further to the Notice of Appeal dated January 30, 2008 appealing the rejection of twice rejected claims including the rejections set forth in the outstanding Final Office Action, this Appeal Brief under 37 C.F.R. § 41.37(d) is responsive to the Final Office Action mailed November 8, 2007 and the Office Action mailed May 25, 2007, in which the Examiner rejected claims 1-20. Inasmuch as the filing date of the Notice of Appeal sets a two-month shortened statutory period for response, this Appeal Brief is timely filed.

If for any reason any extension of time and/or any fee is required to maintain the pendency of the application, including any extension of time and/or appeal fee, authorization is hereby provided to charge any required fee, including any fee for the Appeal Brief and any necessary extension of time fee to Deposit Account No. 19-0089.

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Application No. 10/840,224
Attorney Docket No. P24943
Appeal Brief Under 37 C.F.R. § 41.37(d)

I. Real Party In Interest

The real party in interest is AT&T Knowledge Ventures, L.P., as established by the Change of Name recorded in the United States Patent & Trademark Office on March 24, 2008 at Reel 020692, Frame 0604.

Application No. 10/840,224
Attorney Docket No. P24943
Appeal Brief Under 37 C.F.R. § 41.37(d)

II. Related Appeals and Interferences

None.

III. Status of Claims

Claims 1-20 are pending in this application.

Claims 1-20 stand finally rejected. Appellants appeal the rejection of claims 1-20. In accordance with 37 C.F.R. § 41.37(c)(viii), the claims on appeal are included in the claim appendix.

IV. Status of Amendments

There are no amendments that have not been entered. The claims are in their form as amended in the Amendment under 37 C.F.R. § 1.116, filed February 5, 2007.

V. Summary of Claimed Subject Matter

The following description is made with respect to the independent claims and includes reference to particular parts of the specification. As such, the following is merely exemplary and is not a surrender of other aspects of the present invention that are also enabled by the present specification and that are directed to equivalent structures or methods within the scope of the claims.

Independent claim 1 relates to a method of providing a user with personal caller identification information (specification, page 4, lines 16-23), the method comprising: receiving, at a network service platform, a calling party number in response to a telephone call from the calling party number (specification, page 4, lines 16-23); querying a central, network-based personal address book, using the calling party number, to retrieve personal caller identification information associated with the calling party number and displayable to the user (specification, page 4, lines 16-23); and forwarding network caller identification information supplemented with the personal caller identification information when connecting the telephone call to the user (specification, page 4, lines 16-23), wherein the personal caller identification information is loadable by the user to the central, network-based personal address book (specification, page 4, lines 16-23).

Independent claim 8 relates to a system for providing a user with personal caller identification information (specification, page 5, lines 13-20), the system comprising: a network service platform that receives a calling party number in response to a telephone call from the calling party number (specification, page 5, lines 13-20); and a central, network-based personal address book that is queried, using the calling party number, to retrieve personal caller identification information associated with the calling party number and displayable to the user (specification, page 5, lines 13-20), wherein network caller identification information is supplemented with the personal caller identification information and forwarded to the user when connecting the telephone call to the user (specification, page 5, lines 13-20), and wherein the personal caller identification information is loadable by the user to the central, network-based personal address book (specification, page 5, lines 13-20).

Independent claim 14 relates to a computer readable medium for storing a computer program that provides a user with personal caller identification information, the computer readable medium comprising (specification, page 5, lines 13-20): code that receives a calling party number in response to a telephone call from the calling party number (specification, page 5, lines 13-20); code that queries a central, network-based personal address book, using the calling party number, to retrieve personal caller identification information associated with the calling party number and displayable to the user (specification, page 5, lines 13-20); and code that forwards network caller identification information supplemented with the personal caller identification information when connecting the telephone call to the user (specification, page 5, lines 13-20), and wherein the personal caller identification information is loadable by the user to the central, network-based personal address book (specification, page 5, lines 13-20).

Independent claim 19 relates to a telecommunications system that provides a user with personal caller identification information (specification, page 7, lines 3-16), the system comprising: a network element that determines when a telephone call is being placed to the user in a telecommunications network (specification, page 7, lines 3-16); a network service platform that receives a calling party number from the network element in response to a telephone call from the calling party number (specification, page 7, lines 3-16); a network caller identification database that is queried, using the calling party number, to retrieve network caller identification information (specification, page 7, lines 3-16); and a central, network-based personal address book that is queried, using the calling party number, to retrieve personal caller identification information associated with the calling party number and displayable to the user (specification, page 7, lines 3-16), wherein the network element forwards the network caller identification information supplemented with the personal caller identification information to the user when connecting the telephone call to the user, and wherein the personal caller identification information is loadable by the user to the central, network-based personal address book (specification, page 7, lines 3-16).

VI. Grounds of Rejection to be Reviewed on Appeal

A) Claims 1-9 and 11-20 are rejected as unpatentable under 35 U.S.C. § 103(a) over Karves et al. (U.S. Patent No. 7,085,257, hereinafter “KARVES”) in view of Barchi (U.S. Patent No. 7,187,932, hereinafter “BARCHI”).

B) Claim 10 is rejected as unpatentable under 35 U.S.C. § 103(a) over KARVES in view of BARCHI and further in view Birch et al. (U.S. Patent Application Publication No. 2004/0120473, hereinafter “BIRCH”).

VII. Argument

A. Claims 1-9 and 11-20 are patentable under 35 U.S.C. § 103(a) over Karves et al. (U.S. Patent No. 7,085,257, hereinafter “KARVES”) in view of Barchi (U.S. Patent No. 7,187,932, hereinafter “BARCHI”).

1. Independent claims 1, 8, 14, and 19 are not disclosed, suggested, or rendered obvious by KARVES in view of BARCHI

KARVES and BARCHI do not disclose, suggest, or render the claimed invention obvious. Moreover, Appellants respectfully submit that in the above rejection, as well as in previous rejections, the Examiner has misinterpreted elements of the claimed invention, in particular, the claimed “central, network-based personal address book.”

The claims recite “querying a central, network-based personal address book, using the calling party number, to retrieve personal caller identification information associated with the calling party number and displayable to the user...wherein the personal caller identification information is loadable by the user to the central, network-based personal address book” (using claim 1 as a non-limiting example). Based on this recitation, one of ordinary skill in the art could only conclude that the claimed “central, network-based personal address book,” that is recited in each of the independent claims, comprises personal caller identification information which has been entered by the user. Because the claimed “central, network-based personal address book” (and the information stored therein) is distinct from a conventional network phone directory, this allows the claimed system to “supplement” the network caller identification information with the personal caller identification information from the “central, network-based personal address book,” as recited in the claims.

The Examiner asserts that the claimed “central, network-based personal address book” corresponds to the “network phonebook” in Figure 8 of KARVES. However, the “network phonebook” in Figure 8 is not a central, network-based personal address book. Rather, Figure 8 shows a user interface with results from a *query* of both the local and network phonebook databases in KARVES (KARVES, col. 14, lines 31-37). In contrast, in the claimed invention, the “central, network-based personal address book” is queried and personal caller identification

information is retrieved from this query, which supplements the claimed “network caller identification information.” Because Figure 8 merely depicts a user interface showing *query results* from local and network databases (rather than a searchable central, network-based personal address book), the “network phonebook” in Figure 8 does not disclose the “central, network-based personal address book,” recited in the claims.

Furthermore, neither the local phonebook nor the remote phonebook in KARVES is equivalent to the claimed “central, network-based personal address book,” as set forth in claims 1, 8, 14, and 19. KARVES indicates that the local phonebook or local phonebook database “relates to information stored in a local database such as the local memory in the wireless user terminal” (*i.e.*, information entered and stored in a cell phone directly), while the remote database is “associated with a...network, such as a WLAN database” (*see* KARVES, col. 3, lines 39-43). Thus, the “network phonebook database” in KARVES merely contains a network phone directory, rather than a “personal address book” information (as found in the claimed “central, network-based personal address book”). Additionally, unlike the claimed “central, network-based personal address book,” the “local database” in KARVES is neither “central” nor “network-based.” For at least these reasons, KARVES fails to disclose the claimed “central, network-based personal address book.” Because KARVES fails to disclose the claimed “central, network-based personal address book,” KARVES cannot disclose “querying a *central, network-based personal address book*, using the calling party number, to retrieve personal caller identification information associated with the calling party number and displayable to the user,” as recited in the claims.

Furthermore, KARVES does not teach “forwarding network caller identification information supplemented with the personal caller identification information.” Rather, KARVES teaches using information from either the network phone database or the local phonebook database (KARVES, col. 9, lines 43-56). Although KARVES discloses an embodiment in which the local phonebook and network phonebook databases are queried simultaneously, KARVES does not disclose whether or how the information from the local and network phonebook databases would be combined or resolved (KARVES, col. 9, lines 30-39). In fact, in column 9, lines 43-56, KARVES teaches that if the incoming caller is found in the

local phonebook database, then the “caller name ID process ends” (KARVES, col. 9, lines 49). If the incoming caller is not found in the local phonebook database, then the “phonebook application is automatically redirected to the network side,” indicating that query results from the two phonebooks do not supplement one another (KARVES, col. 9, lines 49-53).

Moreover, BARCHI does not cure any of the aforementioned deficiencies of KARVES. Specifically, BARCHI does not disclose, *inter alia*, “querying a central, network-based personal address book, using the calling party number, to retrieve personal caller identification information associated with the calling party number” or “forwarding network caller identification information supplemented with the personal caller identification information” (as recited in claim 1). Furthermore, because BARCHI merely stores a “network copy” of the local copy of the user’s personal address book (BARCHI, col. 7, lines 30-35), the information in the “network copy” and the local copy of the user’s personal address book would be identical. Accordingly, BARCHI cannot teach or suggest “querying a central, network-based personal address book, using the calling party number, to retrieve personal caller identification information associated with the calling party number...; and forwarding network caller identification information supplemented with the personal caller identification information when connecting the telephone call to the user” (as recited in claim 1) because the network and local databases are the same. In other words, it is not clear why one would query both databases in BARCHI, if the network and local databases are the same. Furthermore, the information in the network and local databases would not supplement one another because the network and local databases are the same, according to the teachings of BARCHI. Thus, BARCHI fails to cure the defects found in KARVES.

Furthermore, BARCHI fails to disclose or render obvious the claimed central, network-based personal address book, “wherein personal caller identification information is loadable by the user to the central, network-based personal address book,” as recited in independent claims 1, 8, 14, and 19. Indeed, BARCHI describes a “subscriber profile database [that] can be stored in memory 810 at the PDA 802 and synchronized with a network copy” (BARCHI, col. 7, lines 33-34). However, the system in BARCHI merely stores a network copy of the local copy of the user’s personal address book (BARCHI, col. 7, lines 33-34). Thus, users may not load caller

identification to a network database in BARCHI. Rather, user information may only be loaded to the local copy, which, in turn, may be copied to the network database. This is contrary to the description of the claimed central, network-based personal address book (and the advantages thereof), as set forth in the claims. Thus, although the Examiner relies upon BARCHI to disclose this feature, BARCHI fails to disclose this feature, for the aforementioned reasons. As the Examiner acknowledges that KARVES fails to disclose this feature (*see* page 3 of the Office Action dated November 8, 2007), this element of the claims cannot be found in KARVES. Accordingly, both KARVES and BARCHI (alone or in combination) fail to disclose or render obvious all of the elements of the claimed invention.

In addition, the disparate manner in which the system in BARCHI operates also renders it difficult to resolve and combine with the teachings of KARVES; accordingly, these teachings of the cited publications have been improperly combined. Even in view of recent clarification of standards for combining prior art by the Supreme Court (e.g., *KSR International v. Teleflex*), Appellants submit that there is no logical reason to combine the cited publications. As explained in Section 2142 of the MPEP, “[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, ...[127 S. Ct. 1727 (2007)], 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit. The Federal Circuit has stated that ‘rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.’ ” *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

The Examiner does not provide proper reasons why the claimed invention would be obvious. Rather, the Examiner merely concludes that it would have been obvious to one skilled in the art at the time the invention was made to combine the teachings of KARVES and BARCHI “in order to have a more efficient system and allowing [a] network subscriber to access and update his or her contact data while mobile or traveling” (see page 3 of the outstanding Office Action). Appellants submit that the Examiner is relying upon impermissible hindsight by relying upon the disclosed advantages of the claimed invention, as provided in Appellants’ own

specification, as a roadmap for combining the cited publications. Moreover, the Examiner's conclusions are mere speculation. The Examiner has cited no evidence that the proposed combination will result in the asserted advantages.

Furthermore, upon review of the exemplary rationales provided in MPEP § 2143, it appears that the Examiner has not relied upon any of these exemplary rationales. Although this list is not an exhaustive list of rationales used to support a *prima facie* case of obviousness, this list simply accentuates that, in the present case, the Examiner has not provided a "clear articulation of the reason(s) why the claimed invention would have been obvious," as set forth in section 2141 of the MPEP and the Supreme Court's decision in *KSR International*. On the contrary, the Examiner merely focuses upon the advantages of the claimed invention in seeking guidance on why one skilled in the art would combine the cited publications, which the Examiner acknowledges do not teach or even suggest all of the elements of the claimed invention. Appellants submit that this is the very definition of impermissible hindsight.

Assuming, *arguendo*, that the Examiner's obviousness conclusion is based upon the assertion that it would have been "obvious to try," this rationale would be inappropriate because such a rationale is only proper where there is "a finite number of identified, predictable solutions, with a reasonable expectation of success." However, there are a myriad of ways in which one could create "a more efficient system...allowing [a] network subscriber to access and update his or her contact data while mobile or traveling" (*see* page 3 of the outstanding Office Action). Furthermore, because the Examiner points out that *BARCHI* indicates that the invention in *BARCHI* has already achieved this objective, it remains unclear why one skilled in the art would combine the teachings of *BARCHI* and *KARVES* (*see* page 3 of the outstanding Office Action). Therefore, the Examiner has not set forth a *prima facie* case of obviousness because the Examiner has not provided a sound rationale for combining the teachings of these publications.

Appellants respectfully submit that there is nothing in *KARVES* or *BARCHI* that would have led a person of ordinary skill in the art to the modifications as proposed by the Examiner, and even if such modifications were made, there certainly would not be any reasonable expectation of success. The modifications proposed by the Examiner are so far removed from

the basic concept of KARVES and BARCHI that little of their original teaching remains. Appellants respectfully submit that KARVES and BARCHI do not render obvious the present invention. For at least these reasons, Appellants respectfully submit that KARVES in view of BARCHI do not render claims 1, 8, 14, and 19 obvious, and respectfully request withdrawal of the rejections for obviousness over KARVES in view of BARCHI.

For at least these reasons, Appellants respectfully submit that KARVES and BARCHI fail to disclose, suggest, or render obvious a “method of providing a user with personal caller identification information, the method comprising...querying a central, network-based personal address book, using the calling party number, to retrieve personal caller identification information associated with the calling party number and displayable to the user; and forwarding network caller identification information supplemented with the personal caller identification information when connecting the telephone call to the user, wherein the personal caller identification information is loadable by the user to the central, network-based personal address book,” as recited in independent claim 1.

Furthermore, KARVES and BARCHI do not disclose, suggest, or render obvious a “system for providing a user with personal caller identification information, the system comprising...a central, network-based personal address book that is queried, using the calling party number, to retrieve personal caller identification information associated with the calling party number and displayable to the user, wherein network caller identification information is supplemented with the personal caller identification information and forwarded to the user when connecting the telephone call to the user, and wherein the personal caller identification information is loadable by the user to the central, network-based personal address book,” as recited in independent claim 8.

KARVES and BARCHI also do not disclose, suggest, or render obvious a “computer readable medium for storing a computer program that provides a user with personal caller identification information, the computer readable medium comprising ...code that queries a central, network-based personal address book, using the calling party number, to retrieve personal caller identification information associated with the calling party number and

displayable to the user; and code that forwards network caller identification information supplemented with the personal caller identification information when connecting the telephone call to the user, and wherein the personal caller identification information is loadable by the user to the central, network-based personal address book,” as recited in independent claim 14.

Lastly, KARVES and BARCHI fail to disclose, suggest, or render obvious a “telecommunications system that provides a user with personal caller identification information, the system comprising ...a network caller identification database that is queried, using the calling party number, to retrieve network caller identification information; and a central, network-based personal address book that is queried, using the calling party number, to retrieve personal caller identification information associated with the calling party number and displayable to the user, wherein the network element forwards the network caller identification information supplemented with the personal caller identification information to the user when connecting the telephone call to the user, and wherein the personal caller identification information is loadable by the user to the central, network-based personal address book,” as recited in independent claim 19.

In view of the foregoing, Appellants respectfully submit that KARVES alone or in any proper combination with BARCHI, fails to establish a prima facie case of obviousness for independent claims 1, 8, 14 and 19.

2. Claim 2 is not disclosed, suggested, or rendered obvious by KARVES in view of BARCHI

The rejection of claim 2 under 35 U.S.C. § 103(a) as unpatentable over KARVES in view of BARCHI is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Appellants note that claim 2 is dependent upon and includes the subject matter recited in claim 1. Therefore, the obviousness rejection based upon claim 2 is without appropriate basis for at least the reasons set forth by Appellants with respect to claim 1. Moreover, KARVES and BARCHI do not disclose, suggest, or render obvious the combination of elements recited in

claim 2, including determining when a telephone call is being placed to the user in a telecommunications network.

3. Claim 3 is not disclosed, suggested, or rendered obvious by KARVES in view of BARCHI

The rejection of claim 3 under 35 U.S.C. § 103(a) as unpatentable over KARVES in view of BARCHI is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Appellants note that claim 3 is dependent upon and includes the subject matter recited in claim 1. Therefore, the obviousness rejection based upon claim 3 is without appropriate basis for at least the reasons set forth by Appellants with respect to claim 1. Moreover, KARVES and BARCHI do not disclose, suggest, or render obvious the combination of elements recited in claim 3, including querying a network caller identification database, using the calling party number, to retrieve the network caller identification information.

4. Claim 4 is not disclosed, suggested, or rendered obvious by KARVES in view of BARCHI

The rejection of claim 4 under 35 U.S.C. § 103(a) as unpatentable over KARVES in view of BARCHI is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Appellants note that claim 4 is dependent upon and includes the subject matter recited in claim 1. Therefore, the obviousness rejection based upon claim 4 is without appropriate basis for at least the reasons set forth by Appellants with respect to claim 1. Moreover, KARVES and BARCHI do not disclose, suggest, or render obvious the combination of elements recited in claim 4, including a telecommunications network that comprises one of a voice over internet protocol (VoIP) network, a wireless network, and a public switched telephone network (PSTN).

5. Claim 5 is not disclosed, suggested, or rendered obvious by KARVES in view of BARCHI

The rejection of claim 5 under 35 U.S.C. § 103(a) as unpatentable over KARVES in view of BARCHI is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Appellants note that claim 5 is dependent upon and includes the subject matter recited in claim 1. Therefore, the obviousness rejection based upon claim 5 is without appropriate basis for at least the reasons set forth by Appellants with respect to claim 1. Moreover, KARVES and BARCHI do not disclose, suggest, or render obvious the combination of elements recited in claim 5, including logging each telephone call to the user as an entry comprising at least one of the personal caller identification information, date, time, and calling party telephone number.

6. Claim 6 is not disclosed, suggested, or rendered obvious by KARVES in view of BARCHI

The rejection of claim 6 under 35 U.S.C. § 103(a) as unpatentable over KARVES in view of BARCHI is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Appellants note that claim 6 is dependent upon and includes the subject matter recited in claim 1. Therefore, the obviousness rejection based upon claim 6 is without appropriate basis for at least the reasons set forth by Appellants with respect to claim 1. Moreover, KARVES and BARCHI do not disclose, suggest, or render obvious the combination of elements recited in claim 6, including retrieving the logged telephone call information; selecting one entry of the logged telephone call information; adding the entry to the personal address book; and modifying the entry to personalize the caller identification information.

7. Claim 7 is not disclosed, suggested, or rendered obvious by KARVES in view of BARCHI

The rejection of claim 7 under 35 U.S.C. § 103(a) as unpatentable over KARVES in view of BARCHI is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Appellants note that claim 7 is dependent upon and includes the subject matter recited in claim 1. Therefore, the obviousness rejection based upon claim 7 is without appropriate basis for at least the reasons set forth by Appellants with respect to claim 1. Moreover, KARVES and BARCHI do not disclose, suggest, or render obvious the combination of elements recited in claim 7, including retrieving, selecting, adding, and modifying the entry during a web browsing session.

8. Claim 9 is not disclosed, suggested, or rendered obvious by KARVES in view of BARCHI

The rejection of claim 9 under 35 U.S.C. § 103(a) as unpatentable over KARVES in view of BARCHI is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Appellants note that claim 9 is dependent upon and includes the subject matter recited in claim 8. Therefore, the obviousness rejection based upon claim 9 is without appropriate basis for at least the reasons set forth by Appellants with respect to claim 8. Moreover, KARVES and BARCHI do not disclose, suggest, or render obvious the combination of elements recited in claim 9, including a network element that determines when a telephone call is being placed to the user in a telecommunications network.

9. Claim 11 is not disclosed, suggested, or rendered obvious by KARVES in view of BARCHI

The rejection of claim 11 under 35 U.S.C. § 103(a) as unpatentable over KARVES in view of BARCHI is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Appellants note that claim 11 is dependent upon and includes the subject matter recited in claim 8. Therefore, the obviousness rejection based upon claim 11 is without appropriate basis for at least the reasons set forth by Appellants with respect to claim 8. Moreover, KARVES and BARCHI do not disclose, suggest, or render obvious the combination of elements recited in claim 11, including a network caller identification database that is queried, using the calling party number, to retrieve the network caller identification information.

10. Claim 12 is not disclosed, suggested, or rendered obvious by KARVES in view of BARCHI

The rejection of claim 12 under 35 U.S.C. § 103(a) as unpatentable over KARVES in view of BARCHI is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Appellants note that claim 12 is dependent upon and includes the subject matter recited in claim 8. Therefore, the obviousness rejection based upon claim 12 is without appropriate basis for at least the reasons set forth by Appellants with respect to claim 8. Moreover, KARVES and BARCHI do not disclose, suggest, or render obvious the combination of elements recited in claim 12, including a telecommunications network that comprises one of a voice over internet protocol (VoIP) network, a wireless network, and a public switched telephone network (PSTN).

11. Claim 13 is not disclosed, suggested, or rendered obvious by KARVES in view of BARCHI

The rejection of claim 13 under 35 U.S.C. § 103(a) as unpatentable over KARVES in view of BARCHI is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Appellants note that claim 13 is dependent upon and includes the subject matter recited in claim 8. Therefore, the obviousness rejection based upon claim 13 is without appropriate basis for at least the reasons set forth by Appellants with respect to claim 8. Moreover, KARVES and BARCHI do not disclose, suggest, or render obvious the combination of elements recited in claim 13, including a database that logs each telephone call to the user as an entry comprising at least one of the personal caller identification information, date, time, and calling party telephone number.

12. Claim 15 is not disclosed, suggested, or rendered obvious by KARVES in view of BARCHI

The rejection of claim 15 under 35 U.S.C. § 103(a) as unpatentable over KARVES in view of BARCHI is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Appellants note that claim 15 is dependent upon and includes the subject matter recited in claim 14. Therefore, the obviousness rejection based upon claim 15 is without appropriate basis for at least the reasons set forth by Appellants with respect to claim 14. Moreover, KARVES and BARCHI do not disclose, suggest, or render obvious the combination of elements recited in claim 15, including code that queries a network caller identification database, using the calling party number, to retrieve the network caller identification information.

13. Claim 16 is not disclosed, suggested, or rendered obvious by KARVES in view of BARCHI

The rejection of claim 16 under 35 U.S.C. § 103(a) as unpatentable over KARVES in view of BARCHI is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Appellants note that claim 16 is dependent upon and includes the subject matter recited in claim 14. Therefore, the obviousness rejection based upon claim 16 is without appropriate basis for at least the reasons set forth by Appellants with respect to claim 14. Moreover, KARVES and BARCHI do not disclose, suggest, or render obvious the combination of elements recited in claim 16, including code that logs each telephone call to the user as an entry comprising at least one of the personal caller identification information, date, time, and calling party telephone number.

14. Claim 17 is not disclosed, suggested, or rendered obvious by KARVES in view of BARCHI

The rejection of claim 17 under 35 U.S.C. § 103(a) as unpatentable over KARVES in view of BARCHI is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Appellants note that claim 17 is dependent upon and includes the subject matter recited in claim 14. Therefore, the obviousness rejection based upon claim 17 is without appropriate basis for at least the reasons set forth by Appellants with respect to claim 14. Moreover, KARVES and BARCHI do not disclose, suggest, or render obvious the combination of elements recited in claim 17, including code that retrieves the logged telephone call information; code that selects one entry of the logged telephone call information; code that adds the entry to the personal address book; and code that modifies the entry to include personal caller identification information.

15. Claim 18 is not disclosed, suggested, or rendered obvious by KARVES in view of BARCHI

The rejection of claim 18 under 35 U.S.C. § 103(a) as unpatentable over KARVES in view of BARCHI is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Appellants note that claim 18 is dependent upon and includes the subject matter recited in claim 14. Therefore, the obviousness rejection based upon claim 18 is without appropriate basis for at least the reasons set forth by Appellants with respect to claim 18. Moreover, KARVES and BARCHI do not disclose, suggest, or render obvious the combination of elements recited in claim 18, including retrieving, selecting, adding, and modifying the entry during a web browsing session.

16. Claim 20 is not disclosed, suggested, or rendered obvious by KARVES in view of BARCHI

The rejection of claim 20 under 35 U.S.C. § 103(a) as unpatentable over KARVES in view of BARCHI is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Appellants note that claim 20 is dependent upon and includes the subject matter recited in claim 19. Therefore, the obviousness rejection based upon claim 20 is without appropriate basis for at least the reasons set forth by Appellants with respect to claim 19. Moreover, KARVES and BARCHI do not disclose, suggest, or render obvious the combination of elements recited in claim 20, including a telecommunications network that comprises one of a voice over internet protocol (VoIP) network, a wireless network, and a public switched telephone network (PSTN).

B. Claim 10 is patentable under 35 U.S.C. § 103(a) over KARVES in view of BARCHI and further in view Birch et al. (U.S. Patent Application Publication No. 2004/0120473, hereinafter “BIRCH”).

Appellants have noted above the reasons why KARVES and BARCHI do not render obvious the presently claimed invention. The Office Action also acknowledges that KARVES and BARCHI do not teach that the network service platform comprises one of a SCP, SIP feature server, and Parlay gateway. The Office Action therefore relies on BIRCH only to teach a network service platform comprising one of a SCP, SIP feature server, and Parlay gateway.

However, BIRCH fails to remedy the deficiencies in KARVES and BARCHI, discussed above. Specifically, KARVES, BARCHI, and BIRCH (alone or in any proper combination) do not teach “central, network-based personal address book...wherein the personal caller identification information is loadable by the user to the central, network-based personal address book”; or a “system for providing a user with personal caller identification information, the system comprising...a central, network-based personal address book that is queried, using the calling party number, to retrieve personal caller identification information associated with the calling party number and displayable to the user, wherein network caller identification information is supplemented with the personal caller identification information and forwarded to the user when connecting the telephone call to the user,” as recited in independent claim 8 (from which claim 10 depends). Accordingly, the combination of KARVES, BARCHI, and BIRCH fail to disclose or render obvious all of the elements of claim 10.

BIRCH also fails to provide any reason to make any change to KARVES and BARCHI to arrive at the presently claimed invention. There is no apparent reason to combine BIRCH with KARVES and BARCHI. BIRCH relates to a call control system (e.g., call initiation, routing, and switch operation) and voice processing, and is not at all related to network phonebook databases and caller identification systems. In light of the disparate subject matter of these publications, Appellants submit that it would not have been obvious to combine the teachings of BIRCH with those found in KARVES and BARCHI. Accordingly, these

publications are not properly combined, and withdrawal of the outstanding rejections over KARVES in view of BARCHI and further in view of BIRCH is thus respectfully requested.

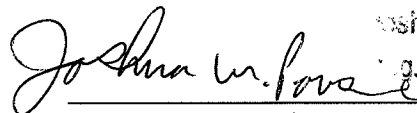
Appellants respectfully submit that a *prima facie* case of obviousness of claim 10 does not result from the combination of KARVES, BARCHI, and BIRCH, and respectfully request withdrawal of the rejection for obviousness.

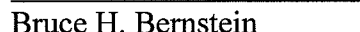
CONCLUSION

Each of claims 1-20 is patentable for the reasons set forth herein. Specifically, the applied art of record does not teach or suggest the combination of features recited in Appellant's claims, and is not combinable in the manner proposed by the Examiner, and even if it were considered to be properly combined, fails to disclose or suggest the unique combination of features recited in Appellant's claims 1-20. Appellants respectfully request that the Board reverse the decision of the Examiner to reject claims 1-20, and remand the application to the Examiner for withdrawal of the rejections.

Thus, Appellants respectfully submit that each and every pending claim of the present application meets requirements for patentability, and that the present application and each pending claim are allowable over the prior art of record.

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VIII. Claims Appendix

1. A method of providing a user with personal caller identification information, the method comprising:

receiving, at a network service platform, a calling party number in response to a telephone call from the calling party number;

querying a central, network-based personal address book, using the calling party number, to retrieve personal caller identification information associated with the calling party number and displayable to the user; and

forwarding network caller identification information supplemented with the personal caller identification information when connecting the telephone call to the user,

wherein the personal caller identification information is loadable by the user to the central, network-based personal address book.

2. The method according to claim 1, further comprising:

determining when a telephone call is being placed to the user in a telecommunications network.

3. The method according to claim 1, further comprising:

querying a network caller identification database, using the calling party number, to retrieve the network caller identification information.

4. The method according to claim 1, wherein the telecommunications network comprises one of a voice over internet protocol (VoIP) network, a wireless network, and a public switched telephone network (PSTN).

5. The method according to claim 1, further comprising:
logging each telephone call to the user as an entry comprising at least one of the personal caller identification information, date, time, and calling party telephone number.

6. The method according to claim 5, further comprising:
retrieving the logged telephone call information;
selecting one entry of the logged telephone call information;
adding the entry to the personal address book; and
modifying the entry to personalize the caller identification information.

7. The method according to claim 6, wherein retrieving, selecting, adding, and modifying the entry occur during a web browsing session.

8. A system for providing a user with personal caller identification information, the system comprising:

a network service platform that receives a calling party number in response to a telephone call from the calling party number; and

a central, network-based personal address book that is queried, using the calling party number, to retrieve personal caller identification information associated with the calling party number and displayable to the user,

wherein network caller identification information is supplemented with the personal caller identification information and forwarded to the user when connecting the telephone call to the user, and

wherein the personal caller identification information is loadable by the user to the central, network-based personal address book.

9. The system according to claim 8, further comprising:

a network element that determines when a telephone call is being placed to the user in a telecommunications network.

10. The system according to claim 8, wherein the network service platform comprises one of a SCP, SIP feature server, and Parlay gateway.

11. The system according to claim 8, further comprising:

a network caller identification database that is queried, using the calling party number, to retrieve the network caller identification information.

12. The system according to claim 8, wherein the telecommunications network comprises one of a voice over internet protocol (VoIP) network, a wireless network, and a public switched telephone network (PSTN).

13. The system according to claim 8, further comprising:

a database that logs each telephone call to the user as an entry comprising at least one of the personal caller identification information, date, time, and calling party telephone number.

14. A computer readable medium for storing a computer program that provides a user with personal caller identification information, the computer readable medium comprising:

code that receives a calling party number in response to a telephone call from the calling party number;

code that queries a central, network-based personal address book, using the calling party number, to retrieve personal caller identification information associated with the calling party number and displayable to the user; and

code that forwards network caller identification information supplemented with the personal caller identification information when connecting the telephone call to the user, and

wherein the personal caller identification information is loadable by the user to the central, network-based personal address book.

15. The computer readable medium according to claim 14, further comprising:

code that queries a network caller identification database, using the calling party number, to retrieve the network caller identification information.

16. The computer readable medium according to claim 14, further comprising:

code that logs each telephone call to the user as an entry comprising at least one of the personal caller identification information, date, time, and calling party telephone number.

17. The computer readable medium according to claim 16, further comprising:

code that retrieves the logged telephone call information;

code that selects one entry of the logged telephone call information;

code that adds the entry to the personal address book; and

code that modifies the entry to include personal caller identification information.

18. The computer readable medium according to claim 17, wherein retrieving, selecting, adding, and modifying the entry occur during a web browsing session.

19. A telecommunications system that provides a user with personal caller identification information, the system comprising:

a network element that determines when a telephone call is being placed to the user in a telecommunications network;

a network service platform that receives a calling party number from the network element in response to a telephone call from the calling party number;

a network caller identification database that is queried, using the calling party number, to retrieve network caller identification information; and

a central, network-based personal address book that is queried, using the calling party number, to retrieve personal caller identification information associated with the calling party number and displayable to the user,

wherein the network element forwards the network caller identification information supplemented with the personal caller identification information to the user when connecting the telephone call to the user, and

wherein the personal caller identification information is loadable by the user to the central, network-based personal address book.

20. The system according to claim 19, wherein the telecommunications network comprises one of a voice over internet protocol (VoIP) network, a wireless network, and a public switched telephone network (PSTN).

IX. Evidence Appendix

None.

Application No. 10/840,224
Attorney Docket No. P24943
Appeal Brief Under 37 C.F.R. § 41.37(d)

X. Related Proceedings Appendix

None.